

REMARKS

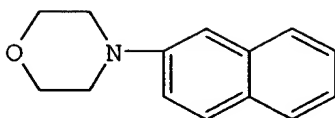
Claims 38, 39, and 41 are pending in the application. Claim 41 has been allowed. Therefore, claims 38 and 39 are at issue in the application.

This amendment is submitted in accordance with 37 C.F.R. §1.116(a) and §1.116(b) in order to present the rejected claims in a better form for allowance or appeal. The amendment is necessary to eliminate rejections under 35 U.S.C. §102(b). This amendment was not presented earlier because the rejections under 35 U.S.C. §102(b) are new grounds of rejection. The amendment should be entered because it places the application in better form for allowance or appeal, and the amendment does not require further searching or present any new issues.

Claims 38 and 39 stand rejected as being anticipated under 35 U.S.C. §102(b) by a Cretcher et al. publication and by Rose et al. U.S. Patent No. 4,003,699 ('699). In view of the amendments to claims 38 and 39, and for the reasons set forth below, it is submitted that claims 38 and 39 are in a form for allowance.

Claims 38 and 39 have been amended to delete hydrogen as an R¹ substituent. Claim 38 also has been amended to delete an unsaturated ring when R¹ and R² are taken together.

The examiner relies upon the Cretcher et al. publication for disclosing 4-β-naphthyl morpholine having the structure



It is submitted that the Cretcher et al. publication does not anticipate amended claims 38 and 39 because the amended claims do not read on 4- β -naphthyl morpholine.

In particular, R^1 and R^2 now are taken together to form a 6-membered partially unsaturated ring. The reference discloses a fully unsaturated ring.

The examiner relies upon the '699 patent for disclosing 3-morpholinophenol. It is submitted that the '699 patent does not anticipate amended claims 38 and 39 because the amended claims do not read on 3-morpholinophenol.

In particular, the R^1 group has been amended to delete hydrogen as a substituent. The '699 patent merely discloses a compound where R^1 is hydrogen.

The Cretcher et al. publication and '699 patent, therefore, do not anticipate claims 38 and 39, and the rejection should be withdrawn.

The present claims also are not rendered obvious by the cited references. In particular, the cited references fail to teach or suggest R^1 substituents other than H, or R^1 and R^2 taken together to form a partially unsaturated ring. The references absolutely fail to provide any motivation for a person skilled in the art to modify the teachings of the Cretcher et al. publication or the '699 patent, and thereby arrive at the presently claimed compound.

Accordingly, it is submitted that the rejection of claims 38 and 39 as being anticipated by

Cretcher et al. and the '699 patent should be withdrawn. It also is submitted that claims 38 and 39 would not have been obvious over the Cretcher et al. publication and the '699 patent, each taken alone or in combination.

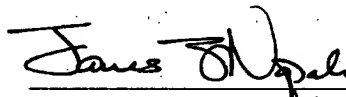
In summary, it is submitted that the claims 38 and 39 are in proper form and scope for allowance. Early and favorable action on the merits is respectfully requested. Claim 41 has been allowed.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By



James J. Napoli
(Registration No. 32,361)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

Chicago, Illinois
September 21, 2004